

### **REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed August 16, 2004 ("Office Action"). At the time of the Office Action, Claims 1-32 were pending in the Application. Applicant amends Claims 1, 2, 6, 14, 15, 18, 20-22, 26 and 30, cancel Claims 3, 9, 23 and 31, and adds new Claims 33-36. Applicant does not admit that these amendments were necessary as a result of any cited art, and submit that no new matter has been introduced by these amendments.

### **Specification Objections**

The Examiner rejects the specification as failing to provide proper antecedent basis for the claimed subject matter. The Examiner states that "the specification does not disclose having a putter head of a greater mass than a second putter head, only that a first putter has a high density and the second club head has a low density. Because the materials are different this does not set forth that the masses would be different because there is nothing within the specification that states that each club head in the set is made of a unitary material." (Office Action, at p. 2). Applicant respectfully disagrees with the Examiner. Page 12 of the specification clearly distinguishes between a "high-density material putter head" and a "low-density material putter head" that both have "the same dimensions and same design." Thus, according to physics, if the volumes of the putter heads are the same, then the one with the higher density would have a greater mass than the one with the lower density. Applicant encourages the Examiner to call the undersigned attorney if the Examiner believes there is a misunderstanding here.

### **Claim Objections**

The Examiner rejects Claims 2 and 3 due to informalities. Applicant has amended Claim 2 as suggested by the Examiner, and has canceled Claim 3.

### **Section 112 Rejections**

The Examiner rejects Claim 31 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has canceled Claim 31 which renders the rejection of this claim moot.

**Section 102(b) Rejections**

The Examiner rejects Claims 1-4, 7, 18, and 26 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,584,769 issued to Sundin ("*Sundin*"). Applicant respectfully traverses these rejections for the reasons discussed below.

With respect to independent Claim 1, Applicant submits that *Sundin* does not teach or suggest each and every limitation of Claim 1, as amended. For example, *Sundin* does not teach or suggest a putter head having "a slot disposed in a longitudinal direction across [a] back face." The Examiner admits at page 7, ¶ 7 of the Office Action that *Sundin* does not disclose this limitation. However, Applicant notes that the Examiner states at page 5, ¶ 5 of the Office Action that "Applicant does not disclose why it is critical to have a slot disposed in a longitudinal direction across the entirety of the back face of the putter head in order to attain the invention. One having ordinary skill in the art would have sought such to be an obvious matter of design choice. The putter head of *Sundin* would perform equally well because it allows the user to strike the ball using more than one striking face."

First, there is no requirement that an Applicant disclose why it is critical to have a certain limitation in a claim. In any event, Applicant does discuss the slot in more than one location within the specification. (*See, e.g.*, page 5 of specification). Second, Applicant disagrees with the Examiner that the slot is an obvious matter of design choice for the putter head and respectfully requests the Examiner to present a reference in support of his position. Third, it does not matter that the putter head of *Sundin* would perform equally well as Applicant's. Therefore, for at least this reason, *Sundin* does not anticipate Claim 1, as amended.

*Sundin* also does not teach or suggest a putter head having "a bevel disposed at a trailing edge of [a] sole face proximate the back face." The Examiner admits at page 7, ¶ 7 of the Office Action that *Sundin* does not disclose this limitation. *Lin* does disclose first bevel 16 and second bevel 17, but these bevels are between the interface of the bottom face of *Lin* and the front and rear faces, respectively. Thus, for at least this additional reason, *Sundin* does not anticipate Claim 1, as amended.

Therefore, *Sundin* does not teach or suggest each and every limitation of Claim 1, as amended. Reconsideration and favorable action are respectfully requested.

Dependent Claims 2, 4-8 and 10-17 depend from independent Claim 1 and are also not anticipated by *Sundin* because they include the limitations of Claim 1 as well as further limitations that further distinguish *Sundin*. Therefore, Applicant respectfully request reconsideration and allowance of Claims 2, 4-8 and 10-17.

With respect to independent Claim 18, Applicant submits that *Sundin* does not teach or suggest each and every limitation of Claim 18, as amended. For example, *Sundin* does not teach or suggest “a putter head affixed to the distal end of the shaft at a location between a longitudinal mid-point and a heel face of the putter head.” Both *Sundin* and *Lin* have their shafts located in a center of the head. Therefore, for at least this reason, neither *Sundin* nor *Lin* anticipates Claim 18, as amended.

*Sundin* also does not teach or suggest a putter head having “a front face, toe face, and back face . . . wherein the face angle of the front face is between one degree and five degrees with respect to vertical and the face angle of the toe face equals the shaft angle with respect to vertical plus between one degree and five degrees.” *Sundin* discloses a putter head having a face angle of a front surface at zero degrees with respect to vertical, which is equal to the angle of the shaft with respect to vertical. *Lin* discloses a putter head having a face angle of a front face at the same angle of it's shaft with respect to vertical. Thus, for at least this additional reason, neither *Sundin* nor *Lin* anticipates Claim 18, as amended.

Therefore, *Sundin* does not teach or suggest each and every limitation of Claim 18, as amended. Reconsideration and favorable action are respectfully requested.

Dependent Claims 19-22 and 24-25 depend from independent Claim 18 and are also not anticipated by *Sundin* because they include the limitations of Claim 18 as well as further limitations that further distinguish *Sundin*. Therefore, Applicant respectfully request reconsideration and allowance of Claims 19-22 and 24-25.

With respect to independent Claim 26, Applicant submits that *Sundin* does not teach or suggest each and every limitation of Claim 26, as amended. For example, *Sundin* does not teach or suggest “a putter head cover comprising a plurality of planar faces operable to engage the front face, top face, and sole face of the putter head and further comprising a shaft detent operable to flexibly engage the shaft of the putter to hold the

putter head cover in place around the putter head.” The Examiner admits at page 7, para. 6 of the Office Action that *Sundin* does not disclose this limitation. However, Applicant notes that the Examiner states at page 7, ¶ 6 of the Office Action that “Applicant does not disclose why it is critical for the club head to have planar faces or to have only a detent in order to attain the invention. One having ordinary skill in the art would have found such to be an obvious matter of design choice. The club head cover of *Meek* would perform equally the same because it protects the club head from being damaged.”

First, there is no requirement that an Applicant disclose why it is critical to have a certain limitation in a claim. Second, Applicant disagrees with the Examiner that the putter head cover with a shaft detent is an obvious matter of design choice and respectfully requests the Examiner to present a reference in support of his position. Third, it does not matter that the club head cover of *Meek* would perform equally the same as Applicant’s (which it does not). Therefore, for at least this reason, neither *Sundin* nor *Meek* anticipates Claim 26, as amended.

Therefore, *Sundin* does not teach or suggest each and every limitation of Claim 26, as amended. Reconsideration and favorable action are respectfully requested.

### **Section 103(a) Rejections**

The Examiner rejects Claims 6, 8, 14-17, 19-20, 22-24, 30, and 32 under 35 U.S.C. § 103(a) as being unpatentable over *Sundin*. The Examiner also rejects Claims 5 and 25 under 35 U.S.C. § 103(a) as being unpatentable over *Sundin* in view of U.S. Patent No. 5,297,603 issued to Meek (“*Meek*”), Claims 9-11, 18, and 27 under 35 U.S.C. § 103(a) as being unpatentable over *Sundin* in view of U.S. Patent No. 5,700,206 issued to Lin (“*Lin*”), Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over *Sundin* in view of U.S. Patent No. 6,001,495 issued to Bristow et al. (“*Bristow*”), Claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *Sundin* in view of U.S. Patent No. 4,314,863 issued to McCormick (“*McCormick*”), Claim 28 under 35 U.S.C. § 103(a) as being unpatentable over *Sundin* in view *Lin*, further in view of *Bristow*, Claim 29 under 35 U.S.C. § 103(a) as being unpatentable over *Sundin* in view *Lin*, further in view of *McCormick*, and Claim 31 under 35 U.S.C. § 103(a) as being unpatentable over *Sundin* in view U.S. Patent No. 1,765,982 issued to Keating (“*Keating*”). Applicant respectfully traverses these rejections for the reasons discussed below.

With respect to independent Claim 27, Applicant submits that independent Claim 27 is not rendered obvious by *Sundin* or *Lin*, alone or in combination, because a *prima facie* case of obviousness has not been established. More specifically, neither *Sundin* nor *Lin* teaches or suggests each and every limitation of Claim 27. For example, neither *Sundin* nor *Lin* teaches or suggests a putter head wherein the “back face defines a slot disposed in a longitudinal direction across the entirety of the back face of the putter head.” For reasons analogous to those above in conjunction with Claim 1, neither *Sundin* nor *Lin* teaches or suggests each and every limitation of Claim 27 and, hence, a *prima facie* case of obviousness has not been established. Reconsideration and favorable action are respectfully requested.

Dependent Claims 28-29 depend from independent Claim 27 and are also not anticipated by, nor rendered obvious by, the cited references because they include the limitations of Claim 27 as well as further limitations that further distinguish the cited references. Therefore, Applicant respectfully request reconsideration and allowance of Claims 28-29.

With respect to independent Claim 30, Applicant submits that independent Claim 30 is not rendered obvious by *Sundin* because a *prima facie* case of obviousness has not been established. More specifically, *Sundin* does not teach or suggest each and every limitation of Claim 30. For example, *Sundin* does not teach or suggest a set of putters . . . “wherein the angle of the first shaft to the first putter head is more nearly vertical than the angle of the second shaft to the second putter head.” As discussed above, the shaft in *Sundin* is vertical for a specific reason: so that it is applicable to right and left handers. (See Abstract). Thus, *Sundin* does not teach or suggest each and every limitation of Claim 30 and, hence, a *prima facie* case of obviousness has not been established. In addition, Applicant disagrees with the Examiner that “it would be obvious to one having ordinary skill in the art to have two clubs having the same approximate dimensions in order to accommodate multiple users,” because it teaches away from *Sundin*’s teaching. And that is having a “universal” putter that accommodates both right and left handed golfers. In addition, Applicant’s invention claimed in Claim 30 goes against conventional wisdom because have two or more putters in “a set” would reduce the number of other clubs in a

golfer's bag, such as additional wedges or utility clubs. Reconsideration and favorable action are respectfully requested.

Dependent Claim 32 depends from independent Claim 30 and is also not anticipated by, nor rendered obvious by, the cited references because Claim 32 includes the limitations of Claim 30 as well as further limitations that further distinguish the cited references. Therefore, Applicant respectfully request reconsideration and allowance of Claim 32.

**New Claims**

Applicant has added new Claims 33-36 and submit that no new matter has been added by these additions. Applicant submits that these new claims are allowable over the cited references.

**CONCLUSION**

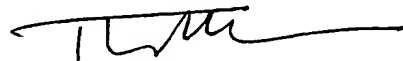
Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all the pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact the undersigned Attorney for Applicant at the Examiner's convenience at (214) 953-6464.

Applicant hereby encloses a separate fee transmittal along with a check in the amount of \$44.00 to satisfy the additional claim fee. Applicant believes no other fees are do. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

**BAKER BOTTS L.L.P.**  
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